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09/972,760	10/05/2001	Akihiko Toyoshima	50P4257.03	4600

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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/972,760
Filing Date: October 05, 2001
Appellant(s): TOYOSHIMA, AKIHIKO

John L. Rogitz
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/28/2008 appealing from the Office action mailed 12/12/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

09/972183

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,450,471	Hanawa et al.	9-1995
5,249,302	Metroka et al.	9-1993

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. Claims 1, 11 and 17-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Hanawa (USP 5450471).

Regarding claims 1, 11 and 17, Hanawa discloses a method and system for providing a multiple format wireless phone (Figs 6-7, 10, 11 and 15) comprising a wireless phone (Fig 6, Ref 1, Figs 7 and , Ref 11, Fig 11, Ref 730 and Fig 15, Ref 780) having a first wireless communication format (Analog or digital, first or second system, Col. 3, lines 9-13) configured to removably receive at least one wireless module (Fig 7, Ref 13, Fig 10, ref 13A, Fig 11, ref 710 and Fig 15, ref 760) having a second wireless communication format (Analog or digital, first or second system, Col. 3, lines 9-13) and said wireless module in electronic data communication with the wireless phone (Figs 7, 10-11 and 15, the telephones is coupled via electronic data communication), said wireless module configured to provide the second format to the phone (Analog or digital, first or second system, Col. 3, lines 9-13), wherein the module includes a mobile station identification number, said wireless phone configured to receive said mobile station identification number upon verification of proper operation of the module to facilitate use of a single phone number with both formats (Fig 6, Ref 9 and 10 used to verify the conditions of the portable telephone and transferring the conditions information and subscriber's number etc...

to the wireless phone; Fig 6, Ref 1, Figs 7 and , Ref 11, Fig 11, Ref 730 and Fig 15, Ref 780, so that the telephones can be use with the same telephone number, See col. 9, lines 48-50, col. 11, line 55 to col. 12, line 59).

Regarding claim 18, Hanawa discloses operational data comprises at least one wireless format (Analog or digital, first or second system, Col. 3, lines 9-13).

Claim Rejections - 35 USC § 103

2. Claims 2-5, 10, 13, 15, 19 and 21 rejected under 35 U.S.C. 103(a) as being unpatentable over Hanawa in view of Metroka (USP 5249302).

Regarding claims 2-3, 13 and 21, Hanawa fails to disclose providing at least one wireless module comprises utilizing at least one wireless format selected from the group consisting of CDMA ONE, CDMA 2000 1X, CDMA 2000 3X, CDMA 1X EV, Wideband CDMA, GSM, GPRS and EDGE. In the same field of endeavor, Metroka discloses a multiple mode telephone system herein a wireless module utilizing at least one wireless format selected from the group consisting of CDMA, TDMA "GSM" (Col. 12, lines 19-39).

Since, Hanawa discloses a dual mode telephone system containing two formats such analog and digital. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply CDMA and TDMA format as disclosed by Metroka into the system and method of Hanawa. The motivation would have been to increase a capacity of the communication system at a minimal cost.

Regarding claims 4-5, 10, 15 and 19, Hanawa fails to disclose providing said wireless module with an electronic serial number for storing to wireless phone. In the same field of endeavor, Metroka discloses providing said wireless module with an electronic serial number for

storing to wireless phone (Col. 14, line 62 to col. 15, Line 3 and col. 15, lines 32-38 and col. 17, lines 1-28).

Since, Hanawa discloses a dual mode telephone system containing two formats such analog and digital wherein a wireless module provides a subscriber's number such as ID information to the wireless phone. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a method and system for providing the radiotelephone serial number of the wireless module to the wireless telephone as disclosed by Metroka into the system and method of Hanawa. The motivation would have been to increase a capacity of the communication system at a minimal cost.

(10) Response to Argument

In the appeal brief the applicant states that Hanawa fails to disclose (1) storing the mobile station identification number to the wireless phone only upon determination that the wireless module provides proper operation in an intended area, to facilitate communication using a common phone number with either format as stated in claims 1 and 17; (2) using a single telephone number for both formats as stated in claim 11 and (3) no motivation to combine the prior arts.

With respect to (1) the applicant states that Hanawa does not disclose storing the mobile station identification number to the wireless phone only upon determination that the wireless module provides proper operation in an intended area to facilitate communication using a common phone number with either format such as change format. In reply, Hanawa discloses a method and system for transferring the subscriber's number and the result of the communication conditions of the portable to the communication unit body after verifying if the portable

telephone is operable with intended area by identifying control channel, radio frequency for connection with a base station in order to facilitate a communication with another device using at least one of formats of the first and second "analog and digital" system. (See col. 9, lines 17-23, 48-55, col. 11, lines 55 to col. 12, line 59, the identifying or detecting means used to check "verify" for conditions of the frequency and control channel of the portable phone and its base station, then forwarding these conditions and mobile ID to the communication unit in order to allow the device to use a common phone number "col. 12, lines 35-45" in both formats "the first and second system" when the device roams from a first to second system. If the device can detect or identify communication conditions "it means that it is operable in this area". For example, the device must exchange the information with the base station before determining if the device works in this area or not. So the portable telephone only transmits the conditions and the subscriber number to the communication unit if the portable is operable in this area, if the portable can not find the base station, it will be disabled). Furthermore, the applicant states that "changing formats" is not the same for changing the radio frequency and control channel between the first and second companies such as analog and digital. In reply, "changing formats" is the same as changing from analog to digital or from first company to second company because they have different format. Therefore, changing format reads on changing from analog to digital or from first company to second company in the broadest term.

With respect to (2), the applicant states that Hanawa fails to disclose using a single telephone number for both formats. In reply, Hanawa discloses a single number used for both formats (col. 11, line 55 to col. 12, line 59 and col. 13, line 59 to col. 14, line 3, a subscriber's

number is used for both portable “first format” and automobile telephone “second format” of communication unit, See “col. 12, lines 35-45”).

With respect to (3), applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

With respect to (3), applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Hanawa discloses a method and system for allowing a portable and mobile unit which coupled together to form a multi mode such as analog and digital using a single telephone number. Metroka discloses a multimode system and method such as TDMA and CDMA, which include a coupled first and second telephone. The motivation would have been to increase a capacity of the communication system at a minimal cost.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Steven Nguyen

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